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10/649,288	08/27/2003	Larry L. Gillanders	PC-802	5483

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EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/649,288

Applicant(s)

GILLANDERS ET AL.

Examiner

William P. Fletcher III

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005 and 15 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/22/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office action is responsive to the amendment after non-final action filed 05/25/2005 and the election filed 09/15/2005.
2. Claims 1-24 remain pending.

#### ***Election/Restrictions***

3. Applicant's election with traverse of claims 10-18 in the reply filed on 09/15/2005 is acknowledged. The traversal is on the ground(s) that: the examiner has not stated that separate searches and separate examiners are necessary to examine the invention; and separate examination of the inventions represents an undue time and financial burden on both applicant and the Office. This is not found persuasive.

A. The Office's policy and procedure with respect to restriction practice is detailed in MPEP § 808. Applicant will note that a statement of separate searches/examiners is not part of establishing a *prima facie* case of the independent/distinct nature of the inventions.

B. Further, time/financial burdens on the applicant do not form a part of the Office's restriction practice.

C. The requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 09/15/2005.

#### ***Information Disclosure Statement***

5. The information disclosure statement (IDS) submitted on 12/22/2005 was filed after the mailing date of the first Office action on the merits on 02/23/2005. The submission is in

Art Unit: 1762

compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Response to Arguments***

6. Applicant's arguments, see the response, filed 05/25/2005, with respect to the objection to the specification (abstract), set-forth in the Office action mailed 02/23/2005, have been fully considered in view of applicant's amendment and are persuasive. The objection has been withdrawn.

7. Applicant's arguments filed 05/25/2005 have been fully considered but they are not persuasive.

A. Applicant argues that applicant's provisional application 60/406,602 antedates the filing date of Kruse, this reference is not available as prior art under 35 USC § 102(e). The examiner disagrees.

According to MPEP § 2136.05, a rejection under 35 USC § 102(e) can be overcome by antedating the reference with applicant's earlier provisional application "if 35 USC 119 is met and the...provisional application "supports" (conforms to 35 USC § 112, first paragraph, requirements) all the claims of the U.S. application." A careful review of applicant's provisional application reveals that this application does not support all of elected claims 10-18.

Specifically, claim 10 recites "cleaning the pipes with a non-liquid agent." The provisional application discloses only cleaning with an abrasive material entrained in a liquid- and oil-free compressed air stream [11:25-30]. This does not support the other embodiments encompassed by the term "non-liquid." For example, non-liquid includes using only gas (which

Art Unit: 1762

include gases other than air) or using only solid. None of these embodiments are supported by the disclosure of the provisional application.

Consequently, because all of elected claims 10-18 are not supported by the provisional application, applicant may not antedate Kruse by relying on the filing date of this provisional application. Consequently, this argument is not persuasive.

B. With respect to the features cited in the paragraph bridging pages 9 and 10 on the response, applicant argues:

It is clearly improper for the examiner to arbitrarily ignore any of the novel features of these claims. Under the rules, if the applicant requests the examiner to cite each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that all the claimed features of claims 2-7 and 10-24 are obvious under sec. 103. If actual references are not cited and supplied to the applicant to show these unsubstantiated opinions and assertions mentioned in their rejection, the applicant respectfully requests removal of the 103 rejection for at least these reasons alone (emphasis in original).

The examiner acknowledges this argument and responds as set-forth below.

In the Office action mailed 02/23/2005, the examiner referred to various limitations as “common and conventional” or “well-known” in the art. The examiner was, in these instances, taking official notice of these facts. The practice of taking official notice is sanctioned by USPTO practice and procedure and governed by MPEP § 2144.03. Perhaps this is the “rule” applicant was referring to. The examiner strongly encourages applicant to review all of MPEP § 2144.03. The portion of this section relevant to the present situation reads as follows (emphasis added):

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b)....

Art Unit: 1762

Because applicant has not specifically pointed out the supposed errors in the examiner's taking of official notice by stating why the noticed fact is not considered to be common knowledge or well-known in the art, this traversal is not adequate and the examiner is not obliged to provide any documents in support of the position set-forth in the prior Office action. MPEP § 2144.03 goes on to state:

If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate.

Because, as noted above, applicant's traversal is not adequate, those facts officially noticed in the Office action mailed 02/23/2005 are taken to be admitted prior art.

C. The remainder of applicant's arguments grow out of the above and are, consequently, not persuasive.

#### ***Claim Objections***

8. Claim 12 objected to because of the following informalities: this claim is missing a period. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Art Unit: 1762

A. Claim 10 recites “restoring...to service in less than approximately 96 hours.” This limitation is indefinite because it is inclusive of immediate restoration to service. Because immediate restoration is clearly not envisioned by applicant (i.e., testing and clean-up of materials must, at least, take place before the pipes can be restored to service) the lower bound of this range of time is unclear and, because applicant gives no minimum criteria which must be met prior to restoring to service, one of ordinary skill in the art would not be able to determine this lower bound.

B. Claim 11 recites “diameters of approximately 3/8 of an inch to approximately 6 inches and greater.” This limitation is indefinite because it is inclusive of infinitely large diameters. Because infinitely large diameters are clearly impractical, the upper bound of this diameter range is unclear and, because applicant given no criteria by which the largest serviceable pipe sizes may be determined, one of ordinary skill in the art would not be able to determine this upper bound.

C. Claim 12 recites “no less than approximately 4 mils.” This limitation is indefinite because it is inclusive of infinitely large thicknesses. Because infinitely large thicknesses are clearly impractical, the upper bound of this thickness range is unclear and, because applicant given no criteria by which the largest thicknesses may be determined, one of ordinary skill in the art would not be able to determine this upper bound.

D. In light of the foregoing, and because every dependent claim necessarily incorporates all of the subject matter of the claim(s) from which it depends, the metes and bounds of elected claims 10-18 are impossible to determine.

***Claim Rejections - 35 USC § 102***

11. The rejection of claims 1, 8, and 9 under this heading in the prior Office action is moot in view of applicant's election of claims 10-18. It remains the examiner's position, for the reasons set-forth in paragraph 7 above, that these claims are anticipated by Kruse for the reasons set-forth under this heading in the prior Office action.

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. **Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kruse (US 6,739,950 B1).**

A. These claims are rejected for the reasons set-forth under this heading in the prior Office action.

B. The rejection of claims 2-7 and 19-24 under this heading in the prior Office action is moot in view of applicant's election of claims 10-18. It remains the examiner's position, for



the reasons set-forth in paragraph 7 above, that these claims are anticipated by Kruse for the reasons set-forth under this heading in the prior Office action.

### ***Conclusion***

15. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Tuesday through Saturday, 0700h to 1730h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/649,288

Art Unit: 1762

Page 9

05/15/2006

A handwritten signature in black ink, appearing to read "William Phillip Fletcher III", written over a horizontal line.

William Phillip Fletcher III  
Patent Examiner (FSA), USPTO  
Art Unit 1762

Alexandria, VA